

Application No.: 09/934031

Case No.: 56091US002

### **Remarks**

The Office Action dated November 1, 2004 has been received and reviewed. Claims 1, 31, and 37 have been amended. The pending claims are claims 1, 4-8, 15-28, 30-33, and 36-41.

### **Restriction Requirement**

Claims 38-41 were withdrawn from consideration as being directed to a non-elected invention. Applicants affirm this restriction without traverse.

### **The 35 U.S.C. § 112 Rejection**

Claims 1, 31, and 37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant traverses this rejection.

However, to further move this case towards issuance, Applicant has amended claims 1, 31, and 37. Reconsideration and withdrawal is respectfully requested.

### **The 35 U.S.C. § 102 Rejection**

Claims 1, 4-5, 23-25, 30, and 36 were rejected under 35 U.S.C. § 102(b) as being anticipated by May.

Applicant traverses this rejection and submits that claims 1, 4-5, 23-25, 30, and 36 are not anticipated by May for at least the following reasons. For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference. See M.P.E.P. § 2131.

Applicant submits that May does not teach each and every element of claims 1, 4-5, 23-25, 30, and 36. For example, independent claim 1 recites an article that includes a tape and a layer of retroreflective beads that are partially embedded in a non-adhesive side of the tape. Independent claims 23 and 36 each recite a layer of retroreflective beads that are partially embedded in a second side of a foam backing.

In contrast to claims 1, 23, and 36, May teaches pavement marking tape that includes an elastomeric body 2 having reflecting material 4 attached to the top surface of the body 2. See May, column 3, lines 33-40. May further teaches that the reflecting material 4 is preferably a thin

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retroreflective sheet including a polymeric support sheet in which a monolayer of transparent microspheres or beads are embedded. *See id.* at column 3, lines 44-47. The reflective material 4 includes a back reflector 28, a transparent matrix 31, and a light-returning layer of small transparent spheres 33 embedded in the transparent matrix 31 in optical connection with the back reflector 28. *Id.* at col. 4, lines 15-26.

According to the Office Action, the layer of reflective microspheres taught by May includes "glass beads with an aluminum coating." *See* Office Action, page 4, line 5. In other words, the Office Action alleges that the equivalent of the layer of retroreflective beads recited, e.g., in claim 1 of the present application is both the beads 33 combined with the back reflector 28 in May.

As such, the layer of reflective microspheres taught by May is not partially embedded in the non-adhesive side of the body 2. Instead, the sheet 4 of May, which includes the microspheres 33 and back reflector 28, is attached to the top surface 5 of the body 2 using a pressure-sensitive adhesive coated onto the backside of the back reflector 28. In other words, the back reflector 28, which is allegedly a part of the layer of reflective microspheres, is not embedded in the body 2. Therefore, May does not teach each and every element of independent claims 1, 23, and 36.

Claims 4-5, 24-25, and 30, which depend from either independent claim 1 or 23, are patentable over May for the same reasons as presented above for independent claims 1 and 23. In addition, each of claims 4-5, 24-25, and 30 recite additional elements that further support patentability when combined with either independent claim 1 or 23.

For at least the above reasons, Applicant submits that claims 1, 4-5, 23-25, 30, and 36 are patentable over May. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

### **The 35 U.S.C. § 103(a) Rejection**

Claims 6-8, 26-28, 31-33, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over May.

Applicant traverses this rejection and submits that claims 6-8, 26-28, 31-33, and 37 are not *prima facie* obvious in view of May because such reference does not teach all of the elements

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of claims 6-8, 26-28, 31-33, and 37. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 6-8, which depend from independent claim 1, and claims 26-28, which depend from independent claim 23, include all of the elements of the independent claims that they depend from. As such, claims 6-8 and 26-28 include a layer of retroreflective beads that are partially embedded in the non-adhesive side of a tape (claims 6-8) or a foam backing (claims 26-28). As stated above in regard to the 35 U.S.C. § 102(b) rejection of claims 1 and 23, May does not teach such a partially embedded layer of retroreflective beads. Therefore, because May does not teach all of the elements of claims 6-8 and 26-28, such claims are not *prima facie* obvious in view of May.

Further, independent claims 31 and 37 recite a layer of retroreflective beads that are partially embedded in the non-adhesive side of a medical tape. As stated above, May does not teach a layer of retroreflective beads that are partially embedded in any type of tape, let alone a medical tape. As such, claims 31 and 37 is also not *prima facie* obvious in view of May.

Claims 32-33, which depend from independent claim 31, are not *prima facie* obvious for the same reasons as presented above for claim 31. In addition, claims 32-33 each recite additional elements that further support patentability when combined with independent claim 31.

For at least the above reasons, Applicant submits that claims 6-8, 26-28, 31-33, and 37 are patentable over May. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

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**Summary**

It is respectfully submitted that the pending claims are in condition for allowance. Reconsideration and withdrawal of all rejections are respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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Date

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